



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/763,607	04/19/2001	Cord F. Stahler	2923-436	3440

6449 7590 07/09/2007
ROTHWELL, FIGG, ERNST & MANBECK, P.C.
1425 K STREET, N.W.
SUITE 800
WASHINGTON, DC 20005

EXAMINER

GROSS, CHRISTOPHER M

ART UNIT	PAPER NUMBER
----------	--------------

1639

NOTIFICATION DATE	DELIVERY MODE
-------------------	---------------

07/09/2007

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

PTO-PAT-Email@rfem.com

Office Action Summary

Application No.

09/763,607

Applicant(s)

STAHLER ET AL.

Examiner

Christopher M. Gross

Art Unit

1639

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 November 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11, 13-18, 21-23, 27-52, 56 and 57 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11, 13-18, 21-23, 27-52, 56 and 57 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

Art Unit: 1639

DETAILED ACTION

Responsive to communications entered 11/9/2006. Claims 1-11, 13-18, 21-23, 27-52, and 56-57 are pending. Claims 1-11, 13-18, 21-23, 27-52, and 56-57 are under consideration.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Priority

This application has a filing date 4/19/2001 and is a 371 of PCT/EP99/06316 filed 8/27/1999, which claims priority to German application(s): 19,839,255.9 filed 08/28/1998; 19,839,256.7 filed 08/28/1998; 19,907,080.6 filed 02/19/1999; 19,924,327.1 filed 05/27/1999 and 198 39 254.0 filed 08/28/1998

Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Withdrawn Objection(s) and/or Rejection(s)

The objection to claims 1, 11, 27, 36, and 56 is hereby withdrawn in view of applicant's amendments to the claims.

The rejection of claims 1-11, 13-18, 21-23, 27-52, 56, and 57 under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention is hereby withdrawn in view of applicant's amendments to the claims

Maintained Claim Rejection(s) - 35 USC § 103

Art Unit: 1639

Claims 1-4, 7-11, 13-17, 21-23, 46-49, 51, and 52 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pirrung et al. (US Patent 5,143,854) in view of Derndinger et al. (US Patent 5,239,178).

Claims 27-41, 44, and 45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pirrung et al. (US Patent 5,143,854) in view of Derndinger et al. (US Patent 5,239,178).

Claims 56 and 57 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pirrung et al. (US Patent 5,143,854) in view of Derndinger et al. (US Patent 5,239,178).

Response to Arguments

Applicant argues: (i) Derndinger represents non analogous art; (ii) not all elements are taught in the combined references of Derndinger et al and Pirrung et al.

Applicant's arguments have been carefully considered but they are not deemed persuasive for the following reasons.

(i) Applicant argues, see p 12 paragraph 1 (11/9/2006) that Derndinger et al represents non-analogous art in that confocal microscopy is not related to making biochips as set forth in the instant application or Pirrung et al.

In response to applicant's argument that Derndinger et al represent nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir.

1992). Solely to rebut applicant's argument, evidence provided by US patent 5736257 indicates that confocal microscopy is commonly used as quality control measure in microarray manufacturing (i.e. see figure 5, and column 6, line 12 of patent 5736257). To further solely rebut applicant's argument, confocal microscopy is also used commonly for microarray analysis, as evidenced by US patent 6114123 (i.e. see column 22 line 34-35). Therefore it is the examiner's position that references regarding confocal microscopy are reasonably pertinent to the particular problem of microarray manufacturing with which the applicant and Perrung were each concerned.

(ii) Applicant argues, see p 12 paragraph 3 (11/9/2006) that the device of Derdinger et al does not teach an adjustable location-specific illumination pattern, however applicant's attention is respectfully invited to column 4, lines 13-17 where Derdinger et al teach that it is advantageous to provide adjusting device which makes it possible to move the illumination grid.

In response to applicant's argument, see p 12 paragraph 3 (11/9/2006) , that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., adjusted to conform to the location-specific illumination pattern) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

In particular, it is noted that claims 1(b),27(b) and 56(b) are drawn to an adjustable location-specific illumination pattern which is not taken as an necessary method step, and according to MPEP 2106 II B language that suggests or makes

Art Unit: 1639

optional but does not require steps to be performed does not limit the scope of a claim or claim limitation.

Applicant further argues, see p 12 paragraph 2 (11/9/2006) that the Derdinger device is not capable of detecting whether a particular light source is actually illuminating a particular location of an object. This is not found persuasive because the arguments of counsel cannot take the place of evidence in the record. In re Schulze, 346 F.2d 600, 602, 145 USPQ 716, 718 (CCPA 1965); In re Geisler, 116 F.3d 1465, 43 USPQ2d 1362 (Fed. Cir. 1997) ("An assertion of what seems to follow from common experience is just attorney argument and not the kind of factual evidence that is required to rebut a prima facie case of obviousness.") (see MPEP 2145 I.) In the instant case, Applicant's counsel argues the Derdinger device is designed to scan an object in three dimensions and cannot selectively illuminate specific predetermined areas without error, however counsel does not provide objective evidence establishing this as a fact.

Claims 5 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pirrung et al. (US Patent 5,143,854) in view of Derndinger et al. (US Patent 5,239,178) as applied to claims 1-4, 7-11, 13-17, 21-23, 46-49, 51, and 52 above, and further in view of Cerrina et al. (US Patent 6,375,903 B1).

Applicant does not offer further arguments regarding the above obviousness rejections beyond what was set forth with regard to the 35 U.S.C. § 103 rejections concerning Pirrung et al. (US Patent 5,143,854) in view of Derndinger et al. (US Patent

Art Unit: 1639

5,239,178). To the extent that Applicant is merely repeating their previous argument, the Examiner contends that those issues were adequately addressed in the above sections, which are incorporated in their entireties herein by reference

Maintained Claim Rejection(s) – Double Patenting

Claims 1, 8, 14, and 16 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 5, 6, and 35 of copending Application No. 09/763,914.

The provisional rejection will not be held in abeyance until such time that a terminal disclaimer is filed.

New Claim Rejections - 35 USC § 112

The following is a quotation of the **first** paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-11, 13-18, 21-23, 27-52, and 56-57 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. 37 CFR 1.118 (a) states that "No amendment shall introduce new matter into the disclosure of an application after the filing date of the application".

This rejection is necessitated by Applicant's amendment to the claims.

Claims 1,27 and 56 have each been amended to include building blocks for chemically functional materials as binding materials.

The specification as originally filed provided no implicit or explicit support for chemical building blocks.

Applicants are reminded that it is their burden to show where the specification supports any amendments to the claims. See 37 CFR 1.121 (b)(2)(iii), the MPEP 714.02, 3rd paragraph, last sentence and also the MPEP 2163.07, last sentence.

MPEP 2163.06 notes "If new matter is added to the claims, the examiner should reject the claims under 35 U.S.C. 112, first paragraph - written description requirement. *In re Rasmussen*, 650 F.2d 1212, 211 USPQ 323 (CCPA 1981)." MPEP 2163.02 teaches that "Whenever the issue arises, the fundamental factual inquiry is whether a claim defines an invention that is clearly conveyed to those skilled in the art at the time the application was filed...If a claim is amended to include subject matter, limitations, or terminology not present in the application as filed, involving a departure from, addition to, or deletion from the disclosure of the application as filed, the examiner should conclude that the claimed subject matter is not described in that application. MPEP 2163.06 further notes "When an amendment is filed in reply to an objection or rejection based on 35 U.S.C. 112, first paragraph, a study of the entire application is often necessary to determine whether or not "new matter" is involved. *Applicant should therefore specifically point out the support for any amendments made to the disclosure.*

Art Unit: 1639

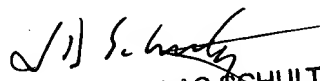
THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher M. Gross whose telephone number is (571)272-4446. The examiner can normally be reached on M-F 9-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, J. Douglas Schultz can be reached on 571 272-0763. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


J. DOUGLAS SCHULTZ, PH.D.
SUPERVISORY PATENT EXAMINER

Christopher M Gross
Examiner
Art Unit 1639